

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 13, 2000. At the time of the Office Action, Claims 1-11 and 13-30 were pending in this patent application. Applicant has amended Claims 19-20 and 22-26 and has canceled Claims 1-11, 13-18, 21, and 27-30 without prejudice or disclaimer. Applicant respectfully submits that these amendments will not require a new search to be conducted and will not necessitate new or different grounds of rejection. Accordingly, Applicant respectfully requests reconsideration and favorable action in this case.

Claims 19, 22 and 26 are Allowable

The Examiner rejects Claims 19, 21, 22 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Foudos* (U.S. Patent Number 4,053,735) in view of *Clary* (U.S. Patent No. 5,187,351). Applicant has cancelled Claim 21 without prejudice or disclaimer.

Foudos discloses a portable unit to which a bank may transfer user-expendable credit via a fixed unit. (Column 2, Lines 32-42). The user may enter an amount of a transaction into the device and select a cash or credit option. (Column 3, Lines 5-55). The user then inserts a check into the device and presses a print key successively to print each digit of the transaction amount on the check. (Column 4, Lines 20-34). The check includes spaces for the user to enter the date, payee name, the user's signature, and the written transaction amount by hand. (Column 4, Lines 20-34, 57-64).

Independent Claim 19, as amended, recites the following limitations:

A portable check encoding device, comprising:
an input device operable to receive a check amount from a user;
a display coupled to the input device and operable to display the check amount entered by the user; and
a portable check printer coupled to the input device and operable to receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check.

Foudos does not disclose, teach, or suggest these features and operation, whether *Foudos* is considered alone or in combination with *Clary*, any other cited reference, or with the knowledge of one having ordinary skill in the art at the time the invention was made. As acknowledged by the Examiner, *Foudos* "fails to disclose that the encoded check amount is encoded in a machine-readable format at a predetermined location on the check." *Foudos* also does not disclose, teach, or suggest a check encoder that encodes a check amount on a check in magnetic ink, as recited by amended Claim 19. However, the Examiner asserts that "in view of *Clary*'s teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify *Foudos*' device so that it has the capability of encoding the check amount in a machine-readable format at a predetermined location on the check."

However, the Examiner has not cited language in either reference or within information commonly known to those skilled in the art to that provides the necessary motivation or suggestion to combine the two references. The device disclosed in *Foudos* has a primary purpose of issuing assured checks using bank credit disbursements to a portable unit, in conjunction with preventing fraudulent tampering with the portable unit. In fact, because the *Foudos* device provides for accounting of user-expendable credit with a bank, there is no need or motivation to print the check amount in a machine-readable format on the MICR line to expedite bank processing of the check at a later time. Furthermore, *Clary* discloses a "back-office" check encoder that does not directly receive user input of a transaction amount. Moreover, *Clary* discloses that "MICR encoding machines are both too bulky and too expensive to be positioned at every teller station." Therefore, there is no suggestion to combine the check encoder of *Clary* with the other limitations of the portable check encoding device recited in Claim 19. In fact, *Clary* teaches away from such a combination. Applicant thus submits that the Examiner's reliance on the *Clary-Foudos* combination to reject claims 19, 21, 22 and 26 is improper.

Furthermore, even if these references were properly combined, neither reference discloses, teaches, or suggests a portable check encoding device that includes a portable check printer that is operable to encode a check amount (received from a user input device) in magnetic ink at a predetermined location on a check. As recognized by the Examiner, *Foudos* does not disclose such a limitation. Furthermore, as described above, *Clary* discloses

a "back-office" check encoder that does not directly receive user input of a transaction amount and also discloses that "MICR encoding machines are both too bulky and too expensive to be positioned at every teller station." Therefore, Clary does not disclose, teach, or suggest a portable check printer and actually teaches away from such a limitation. For at least these reasons, Applicant respectfully requests reconsideration and the allowance of Claim 19, together with the claims that depend from Claim 19.

Claims 20, 23 and 24 are Allowable

The Examiner rejects Claims 20, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Foudos* and *Clary*, and further in view of *Yasui* (U.S. Patent Number 5,583,783). Applicant respectfully submits that there is no suggestion to combine the teachings of *Foudos*, *Clary* and *Yasui* to disclose a portable check encoding device that encodes a check amount in magnetic ink and that stores a list of payee names, that displays the payee names, or that prints a payee name in the payee field of a check. Neither *Foudos* nor *Clary* disclose, teach, or suggest that a payee name is printed on a check or that payee names are stored or displayed by a device. In fact, *Foudos* teaches away from such a limitation by disclosing that "spaces are designated for handwritten entry by the user of the . . . the payee's name". (Column 4, Lines 57-59). *Clary* also teaches away from such a limitation by illustrating checks including a handwritten payee name. (Figures 1 and 4). Furthermore, *Yasui* does not disclose, teach, or suggest any portable device or a check printer that may encode a check amount on a check in magnetic ink. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). There is no such suggestion to combine *Foudos*, *Clary* and *Yasui*, and thus Applicant respectfully submits that the rejection of Claims 20, 23 and 24 is improper.

Furthermore, Claims 20, 23 and 24 depend from Claim 19, which has been shown to be allowable. For at least these reasons, Applicant respectfully requests reconsideration and the allowance of Claims 20, 23 and 24.

Claim 25 is Allowable

The Examiner rejects Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over

Foudos and *Clary*, and further in view of *Howard* (U.S. Patent Number 4,635,219). Applicant respectfully submits that there is no suggestion to combine the teachings of *Foudos*, *Clary* and *Howard* to disclose a portable check encoding device that encodes a check amount in magnetic ink and that prints the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check. Neither *Foudos* nor *Clary* disclose, teach, or suggest that an alphabetical check amount is printed on a check. In fact, *Foudos* teaches away from such a limitation by disclosing that "spaces are designated for handwritten entry by the user", the most important of which is a space for the user to hand-write the amount of the check to confirm the numerical amount imprinted on the check. (Column 4, Lines 57-64). *Clary* also teaches away from such a limitation by illustrating checks including a handwritten alphabetical check amount. (Figures 1 and 4). Furthermore, *Howard* does not disclose, teach, or suggest any portable device or a check printer that may encode a check amount on a check in magnetic ink. Again, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. There is no such suggestion to combine *Foudos*, *Clary* and *Howard*, and thus Applicant respectfully submits that the rejection of Claim 25 is improper.

Furthermore, Claim 25 depends from Claim 19, which has been shown to be allowable. For at least these reasons, Applicant respectfully requests reconsideration and the allowance of Claim 25.

CONCLUSION


Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of all pending claims.

Applicant does not believe that any additional fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicant, at the Examiner's convenience at (214) 953-6986.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Brian W. Oaks
Reg. No. 44,981

Correspondence Address:

Baker Botts L.L.P.
2001 Ross Avenue
Dallas, Texas 75201
(214) 953-6986
brian.oaks@bakerbotts.com

Date: 12/12/00